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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,982	01/22/2004	Achim Kohler	1999CH017/D	5997

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,982

Applicant(s)

KOHLER ET AL.

Examiner

José A. Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,12 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,12 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/070,622.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on September 15, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is vague and indefinite since it is unclear what is optional, i.e., the claim recites an optional further additive, the optional clause is followed by additives Fs and water, but the claim ends with the recitation that W_1 content is in the range of 0.1 to 20%. This indicates that either other, no mentioned component(s), are in the mixture, or that the water is not an optional component or that the optional components are in the mixture. If the latter, then the optional components are not optional, but integral part of the mixture. Therefore the real meaning of the claim cannot be ascertained.

Claims 7-8, 17-22 are vague and indefinite as the basis of the percentages is not recited, i.e., percentage with respect to what, the total weight of the formulation or to with respect to the combination of Ws and Fs, or with respect to the Ws?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7-8, 12 and 17-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohringer et al., US Patent No. 5,622,749.

Rohringer et al. teach a surface-finishing agent containing a Whitening Fluorescent Agent and a polyethylene glycol, (PEG), component. The aqueous composition have PEG having an average molecular greater or equal to 300. The percentage of PEG in the solution is within the claimed range, see column 6, lines 25-34. Rohringer et al. seems to teach all the limitations of the claims or at least the minor modification to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

5. Claims 7-8, 12 and 17-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moren, US Patent No. 3,661,633.

Moren teaches a polyethylene glycol, PEG, composition used to impregnate woods. Moren teaches average molecular weight between 500 and 4,000 and teaches mixtures of the different molecular weight PEGs including low and high molecular weight PEGs so that such mixture have an average molecular weight between 1,000 to 4,000, see column 2, lines 38-64. Moren teaches also the use of fungicides or insecticides and surface finishing agents in the mixture if desired, see column 2, line 65 through

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column 3, line 36, and in column 3, lines 36-52, he teaches that the composition includes a solvent or dispersing medium, such as water, alcohols, etc, to form the dispersion or solution of the polyol and the other components.

Note that the intended use of a composition does not define it and it is office position that claims in a patent application cannot be held to involve invention, if the composition defined in such claims is not novel, and of course, patents for old compositions of matter based on a new use of such composition without change therein may not lend patentability to claims. In re Thuau 30 C.C.P.A. 979, 135 F.2D 344, 57 USPQ 324.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7-8, 12, 17-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ploetz et al., US Patent No. 3,779,791.

Ploetz et al. teach a Polyethylene Glycol solution used to impregnate paper. The solution includes PEGs having molecular weight from about 1,000 to about 6,000, which falls within the claimed range, see abstract.

Note that optional components include 0% as part of the range and therefore, the composition reads on aqueous solution/dispersion of PEG.

Note that the intended use of a composition does not define it and it is office position that claims in a patent application cannot be held to involve invention, if the composition defined in such claims is not novel, and of course, patents for old compositions of matter.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art "Polyethylene Glycol Compositions."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


José A Fortuna
Primary Examiner
Art Unit 1731

JAF